

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 13-19 are rejected under 35 USC 102(b) over the U.S. patent to Bogan et al.

At the same time, Claims 13-19 are rejected under 35 USC 112.

After carefully considering the Examiner's grounds for rejection of the claims over the art and formal reasons, applicant amended the corresponding claims.

It is believed that Claim 13, the broadest claim on file, should define the features which are not disclosed in the reference applied by the Examiner and cannot be derived from it as a matter of obviousness.

Before the analysis of the prior art it is believed to be advisable to explain the subject matter of the present invention and its new features. The present invention deals with a housing part, on which a radial seal (28) is formed with a radial sealing surface (40). This means that when the housing part (10) shown in Figure 1 is introduced into an

insertion opening (12) (axial direction 12) for closing the housing, the radial seal (28) seals both housing parts perpendicular to the axial direction (12) in the direction of the radial forces (32).

In accordance with the present invention at least one riser dome (36) is formed on the radial seal (28), one piece with it, or in other words so that it is connected with a radial seal (28) to form a one piece element.

The patent to Bogan does not disclose any radial seal, but instead it discloses an axial seal, it can be seen from Figures 4-8. A cover (12) for closing the box (14) is placed on its opening and the seal (18b) is arranged in a closing direction between the cover and the box. As can be seen in a cross section shown in Figure 7, both outer seals (36) are sealed with respect to the closing direction (perpendicular to the cover (38)). The shorter sealing elements (44, 46) also however represent the axial direction (in the closing direction) and in no case are formed on the both outer sealing elements (36). The sealing elements (44, 46) have no riser dome for the sealing ring (36) since they are injection molded separately. In contrast, as defined in Claim 1, the riser dome extends in axial direction (closing direction) outwardly beyond the axial extension of the radial sealing surface (40).

This feature is not disclosed in the patent to Bogan and the reference does not contain any hint or suggestion for such feature.

In connection with the Examiner's question with respect to the gating point, it was respectfully submitted that the gating point is clearly disclosed in the specification and it is well known that the gating point is a point in which the material of the seal is injected during its manufacture by an injection molded process in a corresponding mold. It is believed that Claim 17 does not need any changes; however, if the Examiner is of the opinion that the above mentioned explanation should be introduced into Claim 1, applicants would be pleased to amend Claim 17 correspondingly. The gating point is identified in the specification with reference numeral (42).

The two connecting pieces of Claim 18 are the pieces (44) which extend from the gating point as clearly disclosed in the specification and shown in the drawings.

The Examiner's attention is also respectfully directed to the features of Claim 28. This claim specifically defines that at least one radial dome is formed of one piece with said radial seal so as to form together a one-piece element.

This feature defined in claim 28 is also not disclosed in the patent to Bogan, and this claim should be considered as patentable per se.

The original claims were rejected over the patent to Bogan under 35 USC 102 as being anticipate. In connection with this, it is believed to be advisable to cite the decision In Re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Bogan does not disclose each and every element of the present invention as defined in amended Claim 17. Therefore, the anticipation rejection should be considered as not tenable with respect to Claim 17 and should be withdrawn.

The patent to Bogan also does not disclose any hint, suggestion or motivation for such features. In order to arrive at the present invention from the teaching of the reference, the reference has to be fundamentally modified, and in particular by including into the new features of the present invention which are now defined in amended Claim

17. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, Claim 17 also cannot be considered as obvious from the teaching of the reference. Claim 17 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on Claim 17, they share its allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in

formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,
/Michael J. Striker/

Michael J. Striker
Attorney for Applicants
Reg. No. 27233